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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,881	05/21/2004	Tetsuro Motoyama	R2180.0111/P111-C	8584

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EXAMINER
GRANT II, JEROME

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 October 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>19-44</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>20,22,31 and 34</u> is/are allowed.

6)☒ Claim(s) <u>19,21,23-30,32,33 and 35-44</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☒ Certified copies of the priority documents have been received in Application No. <u>09/425,007</u>.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II
PRIMARY EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

Detailed Action

1.

Claims 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention. These claims support that the claimed features are implemented using

software programming run from a computer. However, there is no language in the

written specification which specifically teaches or suggest that the claimed features are

implemented by software.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 19, 21, 23-30, 32, 33 and 35-44 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Kobori in view of Tuttle.

With respect to claim 19, Kobori teaches an image handing apparatus, comprising: a plurality of input interfaces (analog processor 2 and 3) for inputting image data; first selector switch 26 for selecting one of the interfaces 2 or 3; storage device (buffer 30) having plural images stored; second selector (computer 7) for selecting a second image; a combining circuit 9 for combining first and second images; a third selector circuit (153 and 154) for selecting one of a plurality of receiving devices to receive third data; wherein at least one of the plural receiving devices is an image output device (monitor 15 and printer 17).

While Kobori does teach a computer 7, it is not clear if this computer is the type which has input means such as a keyboard or mouse. However, one could argue that it is inherent that a computer would have a mouse and keyboard.

None-the-less, Tuttle teaches a host computer 122 which has input means 110 for inputting data thereto from a human. Thus the input means 122 serves as a user based input section.

Since, Kobori and Tuttle are both in the art of image handling, the purpose of allowing a user to input selection data would have been contemplated by Kobori as set forth by Tuttle.

It would have been obvious to one of ordinary skill in the art to replace the host computer 7 of Kobori with a computer that has interface means, such as keyboard and mouse, so that a user could select image data that is being processed by the host, which is set forth by Tuttle.

With respect to claims 21 and 30, Kobori teaches combining circuit 9 for combining images from first and second cameras with computer generated images from computer 7. See col. 3, lines 35-40.

With respect to claims 23 and 32, see col. 3, lines 20-27 where text messages are generated from characters.

With respect to claims 24 and 33, the plurality of background images are for example, the image of boy Taro stored in memory 10 according to col. 8, lines 62-69.

With respect to claims 25 and 35, see the interfaces 2 and 3 which correspond with cameras 1 and 27 as the image capturing devices.

With respect to claims 26 and 36, see cameras 1 and 27 as the image capturing devices.

With respect to claims 27 and 37, as best as can be determined, the camera is a network of components which is connected to network devices (analog processors 2 or 3). Inherently, the camera will interface with the analog processors.

With respect to claims 28 and 38, the digitally encoded image data is generated from the image capture device.

With respect to claim 29, Kobori teaches an image handling method, comprising: a first selecting one of a plurality of input interfaces (analog processor 2 or 3) for receiving first data; source switch 26 for selecting a second image from computer 7; combining the first and second data via combiner 9; third selecting means 153 and 154 for selecting among plural output devices (monitor 15 or printer 17).

While Kobori does teach a computer 7, it is not clear if this computer is the type which has input means such as a keyboard or mouse. However, one could argue that it is inherent that a computer would have a mouse and keyboard.

None-the-less, Tuttle teaches a host computer 122 which has input means 110 for inputting data thereto from a human. Thus the input means 122 serves as a user based input section.

Since, Kobori and Tuttle are both in the art of image handling, the purpose of allowing a user to input selection data would have been contemplated by Kobori as set forth by Tuttle.

It would have been obvious to one of ordinary skill in the art to replace the host computer 7 of Kobori with a computer that has interface means, such as keyboard and mouse, so that a user could select image data that is being processed by the host, which is set forth by Tuttle.

With respect to claim 39, Kobori teaches an image handing apparatus, comprising: a plurality of input interfaces (analog processor 2 and 3) for inputting image data; selector switch 26 for selecting one of the interfaces 2 or 3; storage device (buffer 30) having plural images stored; selector (computer 7) for selecting a second image; a combining circuit 9 for combining first and second images; a selector circuit (153 and 154) for selecting one of a plurality of receiving devices to receive third data; wherein at

least one of the plural receiving devices is an image output device (monitor 15 and printer 17).

While Kobori does teach a computer 7, it is not clear if this computer is the type which has input means such as a keyboard or mouse. However, one could argue that it is inherent that a computer would have a mouse and keyboard.

None-the-less, Tuttle teaches a host computer 122 which has input means 110 for inputting data thereto from a human. Thus the input means 122 serves as a user based input section.

Since, Kobori and Tuttle are both in the art of image handling, the purpose of allowing a user to input selection data would have been contemplated by Kobori as set forth by Tuttle.

It would have been obvious to one of ordinary skill in the art to replace the host computer 7 of Kobori with a computer that has interface means, such as keyboard and mouse, so that a user could select image data that is being processed by the host, which is set forth by Tuttle.

With respect to claim 40, Kobori teaches an image handing apparatus, comprising: a plurality of input interfaces (analog processor 2 and 3) for inputting image data; selector switch 26 for selecting one of the interfaces 2 or 3; storage device (buffer 30) having plural images stored; selector (computer 7) for selecting a second image; allowing text data to be entered , see col. 3, lines 20-27 where text messages are generated from characters; a combining circuit 9 for combining first and second images; a selector circuit (153 and 154) for selecting one of a plurality of receiving devices to receive third data; wherein at least one of the plural receiving devices is an image output device (monitor 15 and printer 17).

While Kobori does teach a computer 7, it is not clear if this computer is the type which has input means such as a keyboard or mouse. However, one could argue that it is inherent that a computer would have a mouse and keyboard.

None-the-less, Tuttle teaches a host computer 122 which has input means 110 for inputting data thereto from a human. Thus the input means 122 serves as a user based input section.

Since, Kobori and Tuttle are both in the art of image handling, the purpose of

allowing a user to input selection data would have been contemplated by Kobori as set

forth by Tuttle.

It would have been obvious to one of ordinary skill in the art to replace the host

computer 7 of Kobori with a computer that has interface means, such as keyboard and

mouse, so that a user could select image data that is being processed by the host,

which is set forth by Tuttle.

With respect to claim 41, Kobori teaches selecting means 153 and 154 for selecting

among plural output devices (monitor 15 or printer 17); selecting one of a plurality of

input interfaces (analog processor 2 or 3) for receiving first data; source switch 26 for

selecting a second image from computer 7; combining the first and second data via

combiner 9; wherein at least one of the plurality of receiving devices is an output device

(monitor 15 or printer 17).

With respect to claim 42, Kobori teaches selecting means 153 and 154 for selecting

among plural output devices (monitor 15 or printer 17); selecting one of a plurality of

input interfaces (analog processor 2 or 3) for receiving first data; inputting text to be

combined with input image data, see col. 3, lines 20-27 where text messages are

generated from characters; combining the first and second data via combiner 9; wherein

at least one of the plurality of receiving devices is an output device (monitor 15 or

printer 17).

With respect to claim 43, Kobori teaches a method of reading (via combiner 9) a

first image data received from a selected (switch 26 for selecting) one of plural input

interfaces (2 or 3); reading (via combiner 9) a second image received from one of plural

stored images (stored I computer 7), said second image data based on an input

selection; combiner 9 for after reading the first and second image data, combining it to

produce an output image; and transmitting the output image to one of plural receiving

devices (monitor 15 or printer 17).

What is not positively recited in Kobori is that the second image data is

selectively input be a user.

Since, Kobori and Tuttle are both in the art of image handling, the purpose of

allowing a user to input selection data would have been contemplated by Kobori as set

forth by Tuttle.

It would have been obvious to one of ordinary skill in the art to replace the host

computer 7 of Kobori with a computer that has interface means, such as keyboard and

mouse, so that a user could select image data that is being processed by the host, which is set forth by Tuttle.

Moreover, Kobori does not teach storing a method in software. However, Tuttle teaches software implemented by a host computer 122 for running the printing operation, see col. 5, lines 55-65.

Hence the motivation for storing a program for implementing printing steps would have been contemplated by Kobori as set forth by the specific language in Tuttle regarding computer readable medium for implementing a printing procedure. Tuttle provides the motivation for the obviousness of this procedure. It would have been obvious to replace the host 7 of Kobori with the host computer 122 for storing software for implementing the steps for the printing procedure.

3.

Claims Allowed

Claims 20, 22, 31 and 34 are allowed having been amended to include the subject matter upon which these claims depended.

4.   **Examiner's Remarks**

In the middle of page 10, applicant refers to why circuit 4 cannot be the combining means. Examiner does not rely upon circuit 4 as the combiner. The examiner provided circuit 9 as the means for combining as claimed. Applicant has not provided a reason why this limitation does not address the claimed feature.

Applicant argues at the top of page 11 that the examiner has not provided selecting one of plural stored images as a second image based upon a user input selection. The examiner agrees and has modified the rejection to address this limitation.

Regarding the new claims, 39-44, no rationale has been provided as to why these claims distinguish over Kobori. Rounding out the scope of the invention does not serve as a distinguishing limitation over Kobori.

5.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not
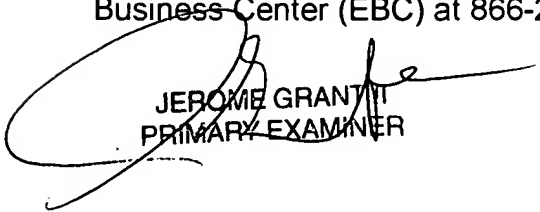
mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

6.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jerome Grant II whose telephone number is 571-272-

7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly A. Williams, can be reached on 571-272-7463. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JEROME GRANT II
PRIMARY EXAMINER